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10/692,504	10/24/2003	Christian Zander	7468 US	9278

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EXAMINER

SALOMON, PHENUEL S

ART UNIT	PAPER NUMBER
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2178

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12/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/692,504

Applicant(s)

ZANDER, CHRISTIAN

Examiner

Phenuel S. Salomon

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the original filing of October 24, 2003. Claims 1-11 are pending and have been considered below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,6,7 and 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2-3 and 5-7 of U.S. copending application No. 09/776040. The subject matter claimed in the instant application is fully disclosed in the U.S. copending application No. 09/776040 and would cover any patent granted on that U.S. copending application No. 09/776040, since the U.S. copending application No. 09/776040 and the instant application are

claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the two sets of claims is that the instant application include a variable where the other instance performs one of several activities as a function of the content of the variable that is not included in the independent claims 1 and 8 of the copending application No. 09/776040. In essence the instant application claims are narrower than the U.S. copending application No. 09/776040 claims. Therefore, it would have been obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *In re Karlson*, 136 USPQ 184 (CCPA 1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6-7, 9-11 are rejected under 35 U.S.C. 102 (b) as being anticipated by Swift et al. (WO 98/57268).

Claim 1: Swift discloses a method of setting up a procedure of a communication taking place between two instances, with one instance being a protocol tester and the other instance being a device under test, comprising the steps executable on the protocol tester of:

a) selecting the instances involved in the communication procedure (various network components can send messages to management) (page 1, paragraph 3, lines 1-9);

b) selecting a protocol layer on the basis of which the communication between the selected instances is to take place (Internet protocol or Transport Control Protocol or other protocol capable of transferring messages is used) (page 7, paragraph 1, line 1-paragraph 2, line 9);

c) selecting abstract communication interfaces of the protocol layer which are involved in the communication (software applications that build interfaces) (page 7, paragraph 2, lines 1-9);

d) selecting communication data (page 9, paragraph 2);

e) setting up a communication procedure executable between the instances through the protocol tester on the basis of the several selecting steps with the selection of the communication data being made graphically and with the parameters so selectable being allocated description files which are used for setting up the communication procedure that is executable between the instances, with further with the communication data selecting step including a graphic configuration of a communication sequence between the instances involved (message created, interfaces produced with PowerBuilder/PowerSockets, specific description file in fig. 3, 222 (message sequence definition)) (page 7, paragraph 3, lines 1-5, fig. 4A, items 406-422) ; and

f) defining within the communication data graphically a message from one instance to the other instance which contains a variable wherein the other instance performs one of several activities as a function of the content of the variable (page 18, paragraph 2) [target object 914 will perform the task based on the content of received data].

Claim 6: Swift discloses the method according to claim 1 wherein the instances involved in the communication are graphically selected, the protocol layer is graphically selected, and the abstract communication interfaces are graphically selected (fig. 4a & 4b).

Claim 7: Swift discloses the method according to claim 1 above wherein the abstract communication interfaces comprise SAPs (Service Access Points) (specific device) (fig. 4b, items 413 & 438).

Claim 9: Swift discloses the method according to claim 1 wherein the communication data selecting step comprises the steps of:

d1) graphically selecting a data format; and d2) graphically setting up the communication sequence between the instances involved (graphical interface to define and specify message) (page 3, paragraph 2, line 1-paragraph 3, line 9).

Claim 10: Swift discloses the method according to claim 9 above wherein the communication sequence setting up step comprises the step of entering source code (customizing software/code for testing purposes) (page 2, paragraph 2, lines 1-7).

Claim 11 is the means claim of claim 1 and is similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being anticipated by Swift (WO 98/57268) in view of Matsui (US 6,560,723).

Claim 2: Swift discloses the method according to claim 1 above but does not explicitly disclose the step of specifying a switch functionality which the other instance executes as a function of the content of the variable. However, Matsui discloses test message function unit that perform transmission and reception based on information content (col. 7, lines 20-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include Matsui's teaching in Swift. One would have been motivated to do so in order to improve the reliability of test data.

Claim 8: Swift discloses the method according to claim 1 above wherein the communication data but does not explicitly disclose comprise data selected from the group consisting of PDUs (Protocol Data Units) and ASPs (Abstract Service Primitives). However, Matsui discloses the communication data comprise at least one type selected from the group consisting of Protocol Data Units (PDUs) and Abstract Service Primitives (ASP) (column 1, lines 55-column 2, lines 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include Matsui's teaching with method of Swift. One would have been motivated to do so in order to create a scenario for use in a conformation test.

7. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being anticipated by Swift (WO 98/57268) in view of Gessel et al. (US 5,732,213).

Claim 3: Swift discloses the method according to claims 1 or 2 above but does not explicitly disclose the step of specifying a loop functionality which the other instance executes as a function of the content of the variable. However, Gessel discloses a simulated node 139 labeled "Loop" is positioned in the center of the display and is a holding point where the simulation waits for another message to be received (col. 11, lines 10-15). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include Matsui's teaching in Swift. One would have been motivated to do so in order to improve the reliability of test data.

Claim 4: Swift and Gessel disclose the method according to claim 3 above, Gessel further discloses the loop functionality is selected from the group consisting of a for-next, a do-while and a while-do functionality (The process then moves to the loop node 139 and waits for the MSC emulator to respond to the request message. If the location updating request is accepted, the BSC simulation receives a location updating accept message at node 142) (col. 11, lines 30-35) [with the loop node 139 involved in the process, therefore these functionalities should be part of the process].

Claim 5: Swift and Gessel disclose the method 3 above, Gessel further discloses comprising the step of specifying a functionality selected from the group consisting of a jump/go-to functionality and an if-then functionality which the other instance executes as a function of the content of the variable (The process then moves to the loop node 139 and waits for the MSC emulator to respond to the request message. If the location updating request is accepted, the BSC simulation receives a location updating accept message at node 142) (col. 11, lines 30-35) [with the loop node 139 involved in the process, therefore these functionalities should be part of the process].

Conclusion

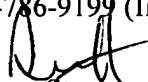
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Autrey et al. (US 5,774,695) discloses protocol interface gateway and method of connecting an emulator to a network.
- b. Engel et al. (US 6,115,393) discloses network monitoring.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phenuel S. Salomon whose telephone number is (571) 270-1699. The examiner can normally be reached on Mon-Fri 7:00 A.M. to 4:00 P.M.(Alternate Friday Off) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272 4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSS
12/17/2007


Stephen Hong
Supervisory Primary Examiner